

REMARKS

Status Summary

In this Response, no claims are added and no claims are canceled. Therefore, upon entry of this Amendment, claims 1-46 will be pending.

Teleconferences with Patent Examiners

Applicant filed an amendment dated April 6, 2004, including a Rule 131 Declaration and attached documents establishing an actual reduction to practice date of at least as early as September 1998. In response, Applicant received an Official Action dated October 20, 2004. In paragraph 5, the Official Action failed to properly consider Applicant's Declaration pursuant to 37 C.F.R. § 1.131 because the actual reduction to practice date established by the Declaration was ignored. On November 1, 2004, Applicant's representative, Gregory A. Hunt, spoke by telephone with Examiner Stefano Karmis. Examiner Karmis agreed that the Declaration had been improperly considered and agreed to withdraw the rejection upon the filing of a Request for Reconsideration. On November 4, 2004, Applicant's representative had a similar telephone conversation with the Examiner's supervisor, Vincent Millen. Examiner Millen agreed that the Declaration had not been properly considered and agreed to call Applicant's representative if any further issues regarding the Declaration remained. Accordingly, it is respectfully requested that the rejection of all the claims pursuant to 35 U.S.C. § 103 be withdrawn. The reasons that the rejections should be withdrawn are set forth in detail below.

Declaration Pursuant to 37 C.F.R. § 1.131

In Applicant's Response dated April 6, 2004, Applicant attached a Declaration pursuant to 37 C.F.R. § 1.131. In paragraph 7 of the Declaration, Applicant, Brian Hamilton, declared that version 1 of the Profit Cents software was reduced to practice at least as early as September 1998. Applicant also attached a contract including a flow chart describing operation of the software and an example of output produced by version 1 of the software.

In paragraph 5 of the Official Action, the Examiner indicated as follows:

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction of practice of the reference to either a constructive reduction to practice or an actual reduction to practice. In the instant application, there is a gap of inactivity between 2 November 1998 and 3 November 1999 when the provisional patent application was filed. Diligence must be shown for the entire critical period. Any interval of inactivity may be excused if established by evidence. (See paragraph 5 of Official Action dated 10/20/2004).

Applicant respectfully submits that the above-quoted paragraph from the Official Action is in error because it ignores the fact that Applicant established an actual reduction to practice date prior to the effective date of the either of the references cited in the current Official Action. Under 37 C.F.R. 1.131, prior invention can be shown by:

1. Reduction to practice prior to the effective date of the reference; or
2. Conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to filing of the patent application. (See 37 C.F.R. § 1.131, September 8, 2000.)

In Applicant's Response, Applicant relied on an actual reduction to practice date of at least as early as September 1998. Accordingly, due diligence between the conception date and the constructive reduction to practice date is irrelevant. Accordingly, Applicant

submits that the Declaration pursuant to 37 C.F.R. § 1.131 and the attached evidence are sufficient to establish an invention date prior to the effective date of Lewis.

In paragraph 6 of the Official Action, the Examiner refused to consider "A Great Report" attached to the 37 C.F.R. § 1.131 Declaration, indicating that the document was inconsistently numbered. In particular, the Examiner correctly noted that the document was internally labeled as having three pages, but that the actual document included four pages with one page having no page number. Applicant respectfully requests entry and consideration of the document because the discrepancy in page numbering was caused by an extra hard return in the electronic version of the document and because the page numbering is irrelevant to the content of the document. Applicant also notes that the document was listed as consisting of four pages in the cover letter accompanying Applicant's response dated April 6, 2004. Accordingly, it is respectfully submitted that the document was properly submitted and should be considered.

Claim Rejections 35 U.S.C. § 103

Claims 1-46 were rejected under 35 U.S.C. § 103(a) as unpatentable over Lewis in view of U.S. Patent No. 6,651,219 to Elliott (hereinafter, "Elliott"). This rejection is respectfully traversed.

As stated in Applicant's Response to the previous Official Action, the Declaration pursuant to 37 C.F.R. § 1.131 establishes an invention date prior to the effective date of Lewis. The Declaration likewise establishes an invention date prior to the effective date of Elliott. Elliott has a 102(e) date of January 11, 1999. The invention date established by the Declaration pursuant to 37 C.F.R. § 1.131 is at least as early as September

1998. Accordingly, the Declaration pursuant to 37 C.F.R. § 1.131 establishes an invention date prior to the effective date of Elliott. Since neither Elliott nor Lewis qualifies as a reference under 35 U.S.C. § 102(e), the rejection of the claims as unpatentable over Lewis in view of Elliott should be withdrawn.

Change of Correspondence Address

Applicant filed a Change of Correspondence Address on April 6, 2004 changing the correspondence of the subject application to the correspondence address associated with customer number 25297. A copy of the Change of Address is attached hereto. Since then, communications have been mailed from the Patent Office to the wrong address. Applicant respectfully requests that the correspondence address be changed to that associated with customer number 25297. In addition, Applicant has been unable to access the application using Applicant's customer number on private PAIR. Accordingly, Applicant respectfully requests that the application be associated with customer number 25297 on private PAIR.

CONCLUSION

In light of the above remarks, it is respectfully submitted that the present application is now in proper condition for allowance, and such action is earnestly solicited.

If any small matter should remain outstanding after the Patent Examiner has had an opportunity to review the above Remarks, the Patent Examiner is respectfully

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requested to telephone the undersigned patent attorney in order to resolve these matters and avoid the issuance of another Official Action.

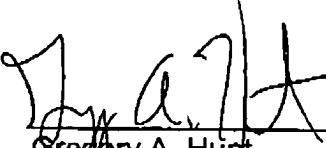
DEPOSIT ACCOUNT

Although no fee is believed to be due, the Commissioner is hereby authorized to charge any fees associated with the filing of this correspondence to Deposit Account No. 50-0426.

Respectfully submitted,

JENKINS, WILSON & TAYLOR, P.A.

Date: November 8, 2004

By: 

Gregory A. Hunt
Registration No. 41,085
Customer No. 25297

1521/3 GAH/sed

Enclosure